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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,440	02/28/2006	Marc Husemann	101769-309-WCG	3424
27386 7590 11/27/2009 GERSTENZANG, WILLIAM C. NORRIS MCLAUGHLIN & MARCUS, PA 875 THIRD AVE, 8TH FLOOR NEW YORK, NY 10022				
EXAMINER				
DESAL, ANISH P				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/537,440

Applicant(s)

HUSEMANN ET AL.

Examiner

ANISH DESAI

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-13 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed on 09/17/09 after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/17/09 has been entered.
2. Objections to claim 14 are moot because said claim is cancelled.
3. The 35 USC Section 112-first paragraph rejections are withdrawn in view of the present amendment and response. However, in view of applicant's amendment, a new 35 USC Section 112-first paragraph rejection is made. Additionally, a new 35 USC Section 112-second paragraph rejection is made.
4. The 35 USC Section 102(b) rejections to claims 1 and 5 based on Wallner (US 3,146,882) are withdrawn in view of the present amendment and response. Wallner does not teach electrically conductive particles as presently claimed.
5. A new 35 USC Section 102 (b) rejection based on DE 196 12 367 cited in the international search report submitted on 06/03/05 is made.

International Search Report (ISR)

6. Applicant has provided following documents as "X" references in the international search report submitted on 06/03/05. The Examiner has reviewed aforementioned reference but not agreed with the citation of the ISR because of the following reasons:

(A) JP 2001-152105 A does not teach that the first PSA is free of electrically conductive particles as presently claimed.

(B) US 5,491,013 does not teach a primer layer with electrically conductive particles as presently claimed.

(C) JP 63-158244 (translation provided by the Examiner) does not teach a primer layer with electrically conductive particles as presently claimed.

(D) JP 63-158241 (translation provided by the Examiner) does not teach "a first electrically conductive primer layer between the carrier layer and said at least one pressure-sensitive adhesive layer...primer layer comprises electrically conductive particles" as presently claimed.

(E) DE 33 27 612A (US 4,702,788 is equivalent) does not teach primer layer with electrically conductive particles as presently claimed.

Claim Objections

7. **Claim 7 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.**

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Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

8. Claim 7 recites the structure of PSA/primer/carrier, which fails to further limit the parent claim 1, because scope of claim 1 already encompasses claim 7.

9. **It is noted that applicant had previously cancelled this claim in the After-final amendment submitted on 04/30/08 which was subsequently entered in the RCE filed on 06/05/08. However, in the present amendment, applicant has again reintroduced this claim.**

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. **Claims 12 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

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11. Claim 12 requires that the electrically conductive particles can be electrically conductive organic salts. Specification as originally filed does not provide support that the electrically conductive particles can be electrically conductive organic salts. While there is support to recite that the electrically conductive materials can be electrically conductive organic salts (e.g. see 0013 of PG pub of this application), there is no support to recite that said conductive particles can be said organic salts.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. With respect to claim 6, this claim recites "shrinkback". However, it is unclear as to what is meant by "shrinkback" and to what degree the PSA exhibits "shrinkback". For the purpose of the examination, shrinkback is interpreted feature associated with elastic material that would shrinkback if stretched.

14. **With respect to claims 7-9, it is submitted that the Examiner had previously rejected claims 7-9 under 112-second paragraph in the OA mailed on 12/18/07. Applicant had then cancelled claim 7 and amended claims 8 and 9 in the after-final amendment submitted on 04/30/08 which was subsequently entered in the RCE filed on 06/05/08. However, in the present amendment, applicant has again reintroduced these claims.**

15. Claim 7 requires PSA tape having following multilayer construction of "pressure-sensitive adhesive layer/electrically conductive primer layer/carrier layer". The language of claim 7, specifically each layer separated by "/" symbol is confusing such that the structure of the PSA tape as claimed is difficult to ascertain. It is unclear as to whether applicant is excluding any intervening layers between for example the PSA layer and the primer layer and between the primer layer and the carrier layer. Additionally, claim 1 requires three layers (PSA layer, primer layer, and carrier layer) therefore are the layers of claim 7 additional layers?

16. Similar observation is made for claims 8 and 9. For the purpose of the examination it is interpreted that there can be intervening layers present between the layers of claims 7-9 and the layers of claim 7 are not additional layers.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by DE 196 12 367 ("DE367") (English translation provided by the Examiner).

18. DE 367 teaches a hardenable silicone resin composition that contains conductive particles, wherein said silicone resin composition is coated on flat carriers (page 3 and "Application-technical inspection" on page 12). The hardenable silicone resin having conductive particles is equated to read on the primer layer. Further, on pages 12-13, under "Separation value", DE367 teaches of applying adhesive tape on surface of a substrate that is coated with aforementioned silicone coating. Additionally, DE 367 is silent as to teaching presence of electrically conductive particles in said adhesive tape.

19. The aforementioned disclosure of DE367 anticipates the presently claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 1, 3, 5-7, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallner (US 3,146,882) in view of Akhter (US 5,958,537), and as evidenced by Roeder (US 3,672,371).

21. With respect to claims 1, 5, and 7, Wallner teaches an antistatic PSA tape comprising a backing (carrier layer) coated with an antistatic primer layer (first electrically conductive primer layer), and a layer of PSA (first PSA) applied to the antistatic primer layer (column 1 lines 10-40). Moreover, Wallner is silent as to teaching the presence of electrically conductive particles in the PSA of his/her invention. Further, Wallner discloses polyacrylate adhesives at column 2 line 10.

22. With respect to claim 6 requirement of the PSA exhibiting a shrinkback, it is submitted that Wallner discloses same PSA as that of claimed by applicant, namely polyacrylate. Additionally, column 6 lines 14-15 of US 3,672,371 to Roeder is relied upon as an evidence to show that polyacrylates are elastomers. Based on this, since polyacrylates are elastomeric material, they would necessarily exhibit shrinkback.

Shrinkback is interpreted as elastic property where a material will return to its original state if stretched like a rubber band.

23. Wallner is silent as to teaching electrically conductive particles in the primer layer (claim 1), the primer layer comprises homogeneously distributed electrically conductive particles (claim 3), and conductive particles as claimed in claim 11, and amount of electrically conductive material as claimed in claims 12 and 13.

24. However, Akhter discloses a static dissipative label (antistatic pressure-sensitive adhesive tape) comprising a backing film (carrier layer), at least one pressure-sensitive adhesive layer, and a primer layer containing electrically conductive particles that is between the carrier layer and the pressure-sensitive adhesive layer (abstract, column 1 lines 4-11, column 1 line 65 to column 2 lines 1-18, and Figure). With regards to claim 3, the electrically conductive materials of Akhter are homogeneously dispersed throughout the binder resin matrix of the primer layer (column 2 lines 4-12).

Additionally, regarding claim 11, the electrically conductive particles of Akhter are metal particles and polymer particles (column 3 lines 29-37). Further, with respect to claims 12 and 13, at column 3 lines 43-47 Akhter discloses that the primer layer comprises at least about 30% conductive particles.

25. It is noted that the primary reference of Wallner discloses an antistatic PSA tape having a primer layer that is antistatic (electrically conductive). Wallner is silent as to

teaching electrically conductive **particles**. Akhter discloses antistatic label which comprises a primer layer having electrically conductive particles.

26. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the electrically conductive particles as required by claims 1, 3, and 11-13 and as taught by Akhter in the primer layer of Wallner, because selecting a known material based on its suitability for its intended use establishes a *prima facie* case of obviousness (MPEP 2144.07).

27. **Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallner (US 3,146,882) in view of Akhter (US 5,958,537), and as evidenced by Roeder (US 3,672,371) as applied to claim 1 above, and further in view of Kitamura et al. (US 5,759,679).**

28. It is noted that while in claim 9 applicant has intended to omit a second electrically conductive primer layer, it is submitted that the claim language of claim 9 does not explicitly exclude a second primer layer.

29. Regarding claims 8 and 9, Wallner is silent as to teaching the structure of the PSA tape as required by claims 8 and 9.

30. However, Kitamura is relied upon to show that such a structure of the PSA tape is known in the art. For example, Kitamura discloses an adhesive tape with foamed substrate (carrier) (abstract). Further, Kitamura discloses that the PSA layer can be

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applied on one or both sides of the foamed substrate (carrier) (column 7 lines 14-20). Additionally, Kitamura discloses that in order to improve the anchoring property of the PSA layers, an undercoat treatment (primer layer) is applied to the surface(s) of the carrier layer (column 7 lines 30-40). Additionally, Example 1-1 of Kitamura discloses application of undercoat to both sides of the carrier and application of PSA layers on both surfaces of the carrier layer.

31. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide PSA tape with the structure as presently claimed, motivated by the desire to form a suitable PSA tape.

32. **Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wallner (US 3,146,882) in view of Akhter (US 5,958,537), and as evidenced by Roeder (US 3,672,371) as applied to claim 1 above, and further in view of Luhmann et al. (US 6,395,389B1).**

33. Wallner is silent with respect to disclosing the PSA tape in the form of a punched product. However, such punched tapes are known in the adhesive art as disclosed by Luhmann.

34. The invention of Luhmann is directed to an adhesive tape strip (see abstract). According to Luhmann "Typical presentation forms [of the adhesive tape] include, **punched adhesive tape strip** sections covered on one side with a release laminate...forms." (column 4 lines 28-45).

35. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the tape in the form of a punched product because selection of a PSA tape in a suitable form such as punched product as taught by Luhamann would have been obvious, motivated by the desire to sell product of Wallner in the form of punched product.

36. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallner (US 3,146,882) in view of Akhter (US 5,958,537), and as evidenced by Roeder (US 3,672,371) as applied to claims 1 and 11 above, and further in view of Craig et al. (US 6,299,799B1).

37. With respect to claims 12 and 13, while Akhter discloses electrically conductive particles including electrically conductive polymers (column 3 lines 30-36), Akhter does not disclose the weight% of said particles.

38. However, Craig discloses ceramer composition having antistatic properties (abstract). Further, the ceramer composition of Craig can be coated onto substrates which may be part of PSA tape (column 4 lines 1-10). At column 4 lines 38-45, Craig discloses ceramer composition of his invention comprises electrically conductive polymer in the amount of 0.05 to 50 weight%.

39. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the electrically conductive particles including

electrically conductive polymers of Akhter in the amount as taught by Craig, motivated by the desire to provide suitable antistatic property to the primer layer.

40. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wallner (US 3,146,882) in view of Akhter (US 5,958,537), and as evidenced by Roeder (US 3,672,371) as applied to claims 1 and 5 above, and further in view of De Jonge et al. (US 6,284,837B1).

41. The invention of Wallner is previously disclosed. Wallner is silent with respect to teaching polymethacrylate PSA.

42. However, De Jonge discloses PSA tapes and labels comprising polymethacrylate adhesives (see abstract and column 3 lines 35-40). Further, the PSA of De Jonge has excellent adhesive nature and good adhesion to substrates of varied nature (column 2 lines 40-45).

43. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the adhesive of De Jonge which reads on the presently claimed invention's adhesive in the invention of Wallner, motivated by the desire to use the PSA that has excellent adhesive nature and good adhesion to substrates of varied nature (column 2 lines 40-45).

Response to Arguments

44. Applicant's arguments filed on 09/17/09 have been fully considered but they are not persuasive.

45. On page 6 of the amendment, with respect to claim 6, applicant argues that shrinkback is a measure of orientation as set forth on page 17 lines 13-14 of the specification of the present invention. Applicant argues that there is nothing in Wallner that would teach or suggest that his adhesive is oriented. Accordingly, Wallner's adhesive cannot have a shrinkback.

46. The Examiner submits that applicant's arguments that shrinkback is a measure of orientation are not commensurate in scope with the presently claimed invention. Presently claimed invention does not require that the PSA is oriented and/or that shrinkback is attributed due to the orientation of PSA. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Accordingly, applicant's arguments are not found persuasive.

47. On pages 7-9 of the amendment, applicant argues that Akhter relies on both conductive particles within the primer layer and the PSA layer. Based on this, applicant

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asserts that one of ordinary skill in the art would not add conductive particles to the primer layer without adding to them to the PSA layer.

48. The Examiner respectfully disagrees. It is submitted that the primary reference of Wallner already makes clear to one of ordinary skill in the art that incorporation of antistatic agent in the adhesive will result in inferior adhesive (see column 1 lines 55-59). Therefore, while Akhter may teach of adding conductive particles (antistatic agent) in both primer layer and PSA layer, the primary reference of Wallner is relied upon to teach that the PSA does not contain any antistatic agent including conductive particles.

49. As to applicant's arguments on page 8 that "Those skilled in the art reading Akhter would find it truly surprising that Applicant's adhesive tape, which has electrically conductive particles only in the primer layer, could pass the antistatic test...", the Examiner submits that said arguments are not found persuasive because the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the combined disclosure of Wallner as modified by Akhter cannot be the basis for patentability when the differences would otherwise be obvious.

50. With respect to claims 8, 9, and 15, it is noted that applicant has essentially incorporated his/her comments as set forth above with respect to Wallner and Akhter references. In response, the Examiner has nothing more to add but to incorporate his comments as set forth above here by reference.

51. On pages 9-10 of the amendment, with respect to claim 10, applicant argues that if the adhesive tape of Wallner reference were provided in the form of a punched product, such as punched product would be different than the PSA tape of applicant's claim 1 in the form of punched product. Applicant argues that the adhesive tape of applicant's claim 1 has electrically conductive particles in the primer layer, but not in the PSA layer; whereas the adhesive tape of Wallner reference has a primer layer which comprises an antistatic polymer that provides ionic conductivity in the presence of moisture.

52. The Examiner respectfully submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). While, Wallner reference does not disclose claimed feature of electrically conductive particles in the primer layer, as set forth in this Office action, Akhter is relied upon to render obvious claimed feature of electrically conductive particles in the primer layer. Accordingly, applicant's arguments are not found persuasive.

Conclusion

53. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

54. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

55. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./
Examiner, Art Unit 1794

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794